

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Drost

Mailed: 25 SEP 2003

Opposition No. 150,298

Baxter International Inc.

v.

Inviro Medical Devices  
Ltd.

Before Seeherman, Rogers and Drost, Administrative Trademark  
Judges.

Drost, Administrative Trademark Judge:

This case now comes up for a decision on the following  
motions:

1. Opposer's Motion to Compel Discovery
2. Applicant's Cross-Motion to Compel Discovery
3. Applicant's Motion to Suspend Its Time to Respond  
to Discovery Requests
4. Applicant's Motion to Amend Answer and Add  
Counterclaim for Cancellation
5. Applicant's Motion for Summary Judgment
6. Opposer's Cross-Motion for Summary Judgment

Background

On October 20, 2000, Inviro Medical Devices Ltd. (applicant) applied to register the mark ULTRALINK (typed) on the Principal Register for "medical devices, namely, cannulae, medical, hypodermic, aspiration and injection needles, medical, hypodermic, aspiration and injection syringes, connectors, ports, catheters and injection sites" in International Class 10. Serial No. 76/151,380. The application was based on an allegation of a bona fide intention to use the mark in commerce.

Baxter International, Inc. (opposer) filed a notice of opposition alleging a likelihood of confusion based on, inter alia, its ownership of three registrations (Registration Nos. 1,721,708; 1,812,016; and 1,821,178).

Both parties have filed numerous motions in this case. Many of these motions were disposed of in the Board's decision dated April 11, 2003. We now address the motions that are currently pending.

Motions to Compel

Opposer has filed a motion to compel applicant to "supplement its Interrogatory answers to Nos. 7, 8, 9, 13, 14, 15, and 16." Opposer's Motion to Compel at 7. Interrogatory 7 requests that applicant identify "all products and/or services sold or intended to be sold by Applicant in the United States in connection with

ULTRALINK, and identify all documents related thereto." Opposer's Motion to Compel, Ex. A, p. 6. Interrogatories 8 ("channels of trade"), 9 (methods of advertising and promotion), 13 (target market), and 14 (competitors) seek more information on how applicant intends to use its mark. Interrogatories 15 and 16 seek information on applicant's first awareness of opposer's marks and opposer's business under the marks. In its opposition to opposer's motion (p. 3), applicant asserts that it "has no other information or documents for its 'intent to use' mark."

We grant opposer's motion to compel in part.

If "a party fails to answer an interrogatory submitted under Rule 33, ... the discovering party may move for an order compelling an answer." Fed. R. Civ. P. 37(a)(2)(B). "[A]n evasive or incomplete disclosure, answer, or response is to be treated as a failure to disclose, answer, or respond." Fed. P. Civ. P. 37(a)(3).

Applicant's unequivocal statement that it has no other documents to identify in response to the interrogatories is a complete response to opposer's request to identify responsive documents. Also, applicant's response to opposer's Interrogatory No. 7 ("Identify the products and/or services sold or intended to be sold by Applicant in the United States") reciting

applicant's goods in its intent to use application is sufficient.

However, we find that applicant's responses to opposer's interrogatories requesting applicant to identify its channels of trade, methods of proposed advertising, target market and competitors (nos. 8, 9, 13, and 14) are incomplete and evasive. Applicant's response to Interrogatory No. 8 requesting channels of trade is typical. Opposer's Motion to Compel, Ex. A, p. 7.

Applicant has not yet used its trademark, but believes that the channel of trade would be one that supplies "medical devices, namely, cannulae, medical, hypodermic, aspiration and injection needles, medical, hypodermic, aspiration and injection syringes, connectors, ports, catheters and injection sites." This quoted language is the identification used in Applicant's ULTRALINK application that was favorably examined by the USPTO examining attorney and for which the examining attorney did not find any third party trademark that would preclude Applicant's registration of the ULTRALINK trademark for "medical devices, namely, cannulae, medical, hypodermic, aspiration and injection needles, medical, hypodermic, aspiration and injection syringes, connectors, ports, catheters and injection sites" sold in the corresponding channel of trade.

Applicant's response, which is simply to refer to the identification of goods, is evasive and nonresponsive. While it is clear that applicant has filed an intent to use application, that fact alone does not mean that applicant is unaware of intended channels of trade, advertising, markets and competitors.

Applicant is ordered to respond to opposer's interrogatories and identify intended channels of trade, advertising, target markets, and competitors to the extent that it is aware of any. Carver v. Velodyne Acoustics, Inc., 202 F.R.D. 273, 274 (W.D .Wash. 2001). ("Interrogatory Number 2 asks the Carvers to identify how each product listed in response to Interrogatory Number 1 infringes each claim. The Carvers provide a minimal response, alleging that the seven products infringe via direct infringement, literal infringement and the doctrine of equivalents." Motion to compel granted).

Applicant was also asked in Interrogatories Nos. 15 and 16 about its first awareness of opposer's marks and business conducted under the marks. Applicant simply responds by saying that it became "aware of all of Opposer's Marks at least as early as when Applicant received a copy of Opposer's opposition." On April 11, 2003, the Board granted opposer's motion to amend its notice of opposition dated August 29, 2002, to delete reference to several of opposer's "LINK registrations and applications and its 'family of marks.'" Instead, Opposer seeks to continue this Opposition based solely on its INTERLINK registrations." Motion to Amend Notice of Opposition, p. 2. This amended notice of opposition now clarifies that Interrogatories 15 and 16 concern when

applicant first learned of opposer's INTERLINK mark and opposer's business conducted under this mark. With this clarification, applicant must now specify whether applicant was first aware of opposer's INTERLINK marks when applicant received a copy of the notice of opposition. If it was aware of the mark earlier, it must provide the date it did actually become aware of opposer's INTERLINK mark and opposer's business conducted under the mark and a statement of the circumstances under which it became aware of the mark, including the names of individuals who gained such knowledge.

Applicant's cross-motion to compel opposer to produce information concerning opposer's other "link" marks is denied. As noted above, on April 11, 2002, the Board granted opposer's motion to amend the notice of opposition to rely only on its INTERLINK marks. Applicant has consented to the motion to amend the opposition and it has answered the amended notice of opposition. Inasmuch as opposer is no longer relying on any other registrations or applications besides the INTERLINK marks, there does not appear to be any reason to further complicate this proceeding by permitting discovery on marks that are not at issue here. Accord Red Wing Co. v. J.M. Smucker Co., 59 USPQ2d 1861, 1863 (TTAB 2001) ("Applicant's objection is sustained to the

extent that [it] is not required to testify about the manufacturing process for its other products"). Applicant has not demonstrated that this discovery is "reasonably calculated to lead to the discovery of admissible evidence." Fed. R. Civ. P. 26(b)(1). Red Wing, 59 USPQ2d at 1863 ("Opposer has not established the relevancy of the information sought").

Applicant's Motion to Amend Answer and  
Add Counterclaim for Cancellation

Applicant's motion to amend its answer and add a counterclaim is granted. Applicant indicates that after it moved to amend its answer and add a counterclaim for cancellation, opposer "verbally conceded that motion." Inviro's Reply to Baxter's Opposition to Inviro's Motion for Summary Judgment, p. 1.<sup>1</sup> Applicant asserts that it was not aware of opposer's alleged naked licensing at the time it filed its answer. It was only after reviewing opposer's discovery responses that applicant would have been able to determine that there was a ground for cancellation on this issue. Opposer's response to applicant's counterclaim is due 30 days from the date of this order.

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<sup>1</sup> While opposer has indicated that it has opposed applicant's motions for summary judgment and to consolidate, it merely notes that "[a]lthough Inviro concurrently filed a motion to amend its answer to include a counterclaim for cancellation at the time it filed this Motion for Summary Judgment, the Board has not ruled on that motion and the counterclaim has not yet become part of the record." Baxter's Response to Inviro's Motion for Summary Judgment & Cross-Motion for Summary Judgment at 1, n.1.

Motions for Summary Judgment

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence of record and any reasonable inferences that may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the non-moving party. See Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 235 USPQ2d 2027, 2029 (Fed. Cir. 1993).

Applicant has moved for summary judgment on the counterclaim on the ground that opposer has "nakedly" licensed the INTERLINK trademark registrations (Nos. 1,721,708; 1,812,016; and 1,821,178).<sup>2</sup> Opposer has

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<sup>2</sup> Applicant filed its motion for summary judgment on the same day that it filed its Motion to Amend Answer and Add Counterclaim for Cancellation. While opposer filed a response to applicant's motion for summary judgment and a cross-motion for summary judgment, it has objected to applicant's motion for summary judgment on the ground that it is untimely inasmuch as it is based on a claim that has not been entered in the record and to which an answer has not been filed. Opposer's Opposition and Cross-Motion for Summary Judgment, p. 1, n.1. We agree with opposer that the motion for summary judgment on a counterclaim



filed a cross-motion for summary judgment on the ground that it has not abandoned these same registrations.

Because we find that there are questions of material fact concerning whether opposer has abandoned its registrations (Nos. 1,721,708; 1,812,016; and 1,821,178), we deny both opposer's and applicant's motions for summary judgment. At a minimum, these issues involve the extent of oversight and supervision opposer exercises over its licensees.

Applicant's Motion to Suspend Its Time  
to Respond to Discovery Requests

Inasmuch as the motions to compel and for summary judgment have now been decided, proceedings are resumed and applicant's motion to suspend is moot.

In summary, to the extent that opposer's motion to compel has been granted, applicant is directed to respond, as indicated herein, to opposer's discovery requests within thirty days from the date of this order.

An answer to applicant's counterclaim is also due thirty (30) days from the mailing date of this decision.

See Trademark Rules 2.106(b)(2)(iii) and 2.121(b)(2).

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that has not yet been entered is premature, but inasmuch as the motion to add a counterclaim has now been granted and the motions for summary judgment have been fully briefed, there is no reason to further delay these proceedings by deferring action on the motions.

**Opposition No. 150,298**

Also, the close of discovery and testimony dates are reset as indicated below.

DISCOVERY PERIOD TO CLOSE: 12/17/03

30-day testimony period for party in position of plaintiff to close: 03/16/04

30-day testimony period for party in position of defendant in the opposition and plaintiff in the counterclaim to close: 05/15/04

30-day rebuttal testimony period for defendant in the counterclaim and plaintiff in the opposition to close: 07/14/04

15-day rebuttal testimony period for party in position of plaintiff in the counterclaim to close: 08/28/04

**IN EACH INSTANCE,** a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.